

Office Action Summary

Application No.

09/714,665

Applicant(s)

URBANSKI ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,8,14,17,19,23,25,26,29,34,35,40-54 and 57-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,8,14,17,19,23,25,26,29,34,35,40-54 and 57-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>17 Sept 2009</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 July 2009 has been entered.

Claim Interpretation

2. Note on interpretation of claim terms - Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.
3. The instant application contains no such clear definition for the phrase “**contextual information**”. In the instant case, the examiner is required to give the term “contextual information” its broadest reasonable interpretation, which the examiner judges to be any information used to target an ad.
4. The claims (e.g., independent method claim 40) are limited to a “**server**”. In general this can be hardware or software, but the specification discloses only a “server device” (p. 4 line 25), a “computer server” (p. 5 line 20) and “a server device 120” (p. 8 line 29 and Fig. 2). The specification does not disclose or suggest that a “server” should be interpreted as software. Hence, the claimed “server” is interpreted to be a machine or apparatus.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 2, 4, 8, 14, 40-46 and 57 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, _F.3d_, 2008 WL4757.
7. The instant claims fail to clearly meet this test. The claims fail to transform a particular article into a different state or thing. The claims are tied to two kinds of machine or apparatus, a "computing/communication device" (e.g., at claim 40 line 5) and a "server" (e.g., at claim 40 line 10), but these devices do not clearly do more than input and output data, which is regarded as merely insignificant extra-solution activity.
8. This rejection could be overcome by amending the second line from the end of each independent claim 40 and 57 to read, "at said server periodically auctioning ...".

Claim Rejections - 35 USC § 102 and 35 USC § 103

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 4, 8, 14, 17, 19, 23, 25, 26, 29, 34, 35, 40-43, 46-50, 53, 54, 60, 63 and 66 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLorme et al. (US005948040A, hereafter "DeLorme").

12. DeLorme et al. teaches (Independent claims 40, 47 and 54) a computer implemented method, computer readable storage medium containing said method and a system of communicating information concerning a target location for which a user seeks information from a server to a user's computing/communication device communicatively connected to said server on a network, the method comprising the steps of:

determining a said target location (*the Palisade restaurant* among restaurants along a user-selected route in Seattle, Washington, col. 49 line 60 to col. 50 line 8) specified by said computing/communication device independently of a current physical location of said computing/communication unit and said server;

providing contextual information (input *food*, col. 24 lines 19-23) about a characteristic of said user (*user preferences*, col. 7 lines 27-30);

at said server retrieving from a database at least one of a plurality of categories of sponsored information (col. 28 lines 1-6 and 56-64, and col. 47 lines 45-56) provided by exclusive sponsors (whoever bears the cost of the "15 % discount" promotion in dialog box **595**, Fig. 5D and col. 50 lines 23-31)¹ for said target location; and

¹ A "sponsor" is "a person that pays for a project or activity", Merriam-Webster's Collegiate® Dictionary, 10th ed.

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delivering said sponsored information (the dialog box **595**) to said computing/communications device (a *PDA*, col. 14 line 66 to col. 15 line 8 and 72 line 62 to col. 73 line 5) over said network (the *Internet*, col. 8 lines 1-3), wherein said sponsored information is determined in part based on said provided contextual information (the *user's preference* for *food*).

13. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

“periodically auctioning off a right of exclusive promotion associated with said target location to said exclusive sponsors and one or more bidders.”

To be functional, process steps must be significantly tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (*In re Bilski*, No. 2007-1130, _F.3d_, 2008 WL4757). “periodically auctioning off a right” does neither.

14. DeLorme et al. teaches at the citations given above claims 2, 4, 8, 14, 17, 19, 23, 25, 26, 29, 34 (where the user selections read on "characteristics of the user"), 35, 41, 42, 48, 49, 60, 63, and 66.
15. DeLorme et al. teaches claims 43 and 50 (col. 22 lines 7-11) and claims 46 and 53 (col. 21 lines 40-48).
16. Claims 44, 45, 51, 52, 58, 59, 61, 62, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (US005948040A) in view of official notice.
17. DeLorme et al. does not teach (claims 44 and 51) delivering sponsored information for a specific period of time. Advertising was commonly sold for a specific period of time at the time of the instant invention. Official notice of this common knowledge or well-known in the art statement was taken in the Office action mailed on 29 June 2007 (Para. 9). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.) Claims 45 and 52 do not add effective limitations because the application does not provide a *clear definition* (MPEP § 2111.01) of “sub-division”. Any division, down to that including only of one sponsor (e.g., *the Palisade restaurant*, para. 10 above) reads on claims 45 and 52.

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18. DeLorme et al. does not teach (claims 58, 59, 61, 62, 64 and 65) that the contextual information is either demographic information related to the user or identification information related to said computing/communication device. "Contextual information" is interpreted as ad targeting information (para. 3 above). It was well known at the time of the invention to target ads to users by their demography or by cookies placed on their computing/communication device, said cookies reading on "identification information related to said computing/communication device". Demography is one of the oldest bases for advertising (e.g., advertising cosmetics in women's magazines). Cookies have been used for more than a decade to store user preferences, which is a basis for targeting.
19. Official notice of these common knowledge or well-known in the art statements was taken in the Office action mailed on 13 August 2008 (para. 13). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (See para. 16 of the Office action mailed 6 February 2009.)
17. Claim 57 is rejected under 35 U.S.C. 102(a) as being anticipated by "Foreclosure Search", a website published on 25 January 1999.²
18. Foreclosure Search teaches a computer implemented method of communicating residential real estate (*number of bedrooms and baths*) foreclosure information concerning a target location (*zip code*) for which a user seeks residential real estate foreclosure information from a server to a user's computing/ communication device communicatively connected to said server on a network, the method comprising the steps of:
- determining a said geographical region (*zip code*) specified by said computing/ communication device independently of a current physical location of said computing/ communication unit and said server;
- at said server retrieving from a database at least one of a plurality of categories of real estate professional contact information (the *Contact Us* button on the webpage) related to residential real estate foreclosure provided by exclusive real estate professionals (the operators of the website) participating in residential real estate foreclosure transactions for said geographical region; and

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delivering said exclusive real estate professional contact information related to residential real estate foreclosure to said computing/communications device over said network.

20. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

“periodically auctioning off a right of exclusive promotion associated with said target location to said exclusive sponsors and one or more bidders.”

To be functional, process steps must be significantly tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (*In re Bilski*, No. 2007-1130, _F.3d_, 2008 WL4757). “periodically auctioning off a right” does neither.

Response to Arguments

19. Applicant's arguments filed with an amendment on 5 May 2009 have been fully considered but they are not entirely persuasive. Applicant argues (pp. 11-12) that the “periodically auctioning” language (para. 13 and 20 above) overcomes the previous rejections under 35 USC 102. As was explained in the advisory action mailed on 8 June 2009, and in para. 13 and 20 above, this language is non-functional and not effective in overcoming the rejection.
20. The examiner has provided an amendment (para 8 above) that would make the subject claim language functional and thereby overcome the rejections given above. However, the examiner hereby makes of record Roth et al., US006285987B1, which the examiner believes could be properly combined with DeLorme to reject all but claim 57 under 35 USC 103(a). The examiner also makes of record the NPL prior art “foreclosurelistings”, which the examiner believes could be properly combined with Roth et al. to reject claim 57 under 35 USC 103(a).

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached on Monday to Wednesday and Friday. The examiner

² Squires (St. Petersburg Times, 23 August 1998) suggests the *Foreclosure Search* website was launched in or before August 1998.

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can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

22. The examiner's supervisor, Robert Weinhardt, can be reached on 571-272-6633. The fax phone number for all *formal* fax communications is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22 September 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688